UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,730	06/12/2001	Kenji Nagoya	B422-161	4879

26272	7590	09/21/2004

COWAN LIEBOWITZ & LATMAN P.C
JOHN J TORRENTE
1133 AVE OF THE AMERICAS
1133 AVE OF THE AMERICAS
NEW YORK, NY 10017

EXAMINER
GARG, YOGESH C

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _12 June 2001_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-22_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-22_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some *   c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)	4) ☐ Interview Summary (PTO-413)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	5) ☐ Notice of Informal Patent Application (PTO-152)
Paper No(s)/Mail Date _8/20/2001_.	6) ☐ Other: _____ .

DETAILED ACTION

Claim Objections

1.   Claims 3 and 14 are objected to because of the following informalities: Claim 3

recites the limitation "generating the setting information" in line 21 on page 41. There is

insufficient antecedent basis for this limitation in the claim. As best understood by the

examiner, the term " generating" is to be replaced by –creating--. Claim 14 is also

objected for similar reasons. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

Claims 8, 11, 19 and 22 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention.

Claims 8, 11, 19 and 22 are generally narrative and indefinite, failing to conform

with current U.S. practice. They appear to be a literal translation into English from a

foreign document and are replete with grammatical and idiomatic errors. The examiner

could not understand the limitation in claims 8 and 19, " information for making the user

select either setting of charge regard or setting of output quality regard is notified to the user. ", and

the limitation in claims 11 and 22, "makes a user set information for the output data during

executing the predetermined process".

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-22 are rejected under 35 U.S.C. 103(a) as being obvious over

Gindlesperger (US Patent 6,397,197) and further in view of an Official Notice.

3.1.   Regarding claims 1-3, Gindlesperger discloses an information processing

apparatus capable of outputting data by using another apparatus connected to a

network (see at least col.6, lines 20-53 and FIG.1. The PrintProSys network server

corresponds to the processing apparatus and vendors represent the another apparatus

connected to a network), comprising:

creating means for creating setting information when data is output, during a

predetermined process of making the output data recognizable by the other apparatus;

and calculating means for calculating an output charge in accordance with the

created setting information, wherein creating the setting information and calculating the

output charge are performed before the output data is sent to the network (see at least

at least col.4, line 55-col.5, line 63. Any vendor corresponds to a printer or the creating means for creating setting information when data is output, see col.1, lines 64 and any print information product/print information goods correspond to the output data recognized by the printer, that is other apparatus. The PrintProSys network server receives the buyer's request for a customized print job and the server with its software programs calculates; which vendors are most suitable, transmits them the buyer's request, receives the price bids and determines the lowest price bid. The PrintProsys server issues an order to the selected vendor for implementing the printing process after receiving the approval from the buyer. The very fact that the printer (s), as defined in col.1, lines 53-67, have to submit bids before receiving a confirmed order, they inherently create the setting information and the server calculates the output charge before the output data, that is the ordered printing product is sent to the vendor/printer via a network. Since it is the network server which calculates the charges, that is the lowest price for the require job the calculation will be done by a software program.

Gindlesperger does not explicitly disclose that a control program creates the setting information. However, the examiner takes an Official Notice of the well-known fact of using software programs to create setting information for print jobs. In view of the Official Notice, it would have been obvious to one of an ordinary skill in the art to have modified Gindlesperger to use control program to create setting information because control programs will help to implement the generating of setting information faster and economically to earn more higher profits.

Regarding claims 4-7, and 9, Gindlesperger discloses their limitations of settling

beforehand before performing the calculation and sending the output data to the

network, the output data is not sent to the network if the charge exceeds a

predetermined value, notifying the user of output charges, for terminating an output

process in response to an operation by the buyer, calculates the output charge in

accordance with charge information stored in the information processing apparatus

(see col.8, lines 3-16, *"Referring to FIG. 1, at step 18 one or more of the vendors receiving the*

vendor's invitation for bid VIFB submits a bid B.sub.i to the system, where the index "i" identifies the

submitting vendor.   Then, at step 20 the PrintProSys.SM. data server detects the lowest price bid and

at step 22 transmits to the buyer a data, WIN, informing of the identity of that lowest price vendor. At

step 24 the PrintProSys.SM. server awaits receipt of approval data APP from the buyer and, upon

receipt, issues an order data ORDER to the selected vendor for purchase of the print item or

procurement of the printing service at the bid price. If step 24 does not receive the approval data APP

no order data ORDER is transmitted.   ". Note: The vendor's quotes are stored in the server

database and from this information the server selects the lowest bid which is notified to

the user for his approval and only if he approves the charges then the process

continues otherwise it is terminated.).

Regarding claim 8, Gindlesperger does not disclose that if setting information is

to be changed, information for making the user select either setting of charge regard or

setting of output quality regard is notified to the user. The examiner takes an Official

notice of the notoriously well-know fact that while placing orders if the buyer changes

the specification during the execution of an order he would have to either pay extra

charges for the changes required or otherwise the buyer should agree to compromise on the quality of the job for the obvious reason the vendor has to make it up for the changes required by the buyer either by getting additional charges or saving cost by reducing the quality. In view of the Official Notice it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Gindlesperger to incorporate the notoriously well-known principle of either selecting the new charges or accept inferior job quality if a change is desired by the buyer because it will allow the vendor to make it up for the changes required by the buyer either by getting additional charges or saving cost by reducing the quality.

Regarding claim 10, Gindlesperger explicitly discloses storing information about vendors their bids in a vendor database (see at least col.4, line 55-col.5, line 10) from which the charges are calculated. Gindlesperger does not state that this information is updated. However, the examiner takes an Official Notice of the fact and benefits of updating any stored information for the obvious reason of being able to know the prevailing rates for any job/services and submit the realistic price quote/information to the buyer. In view of the Official Notice it would have been obvious to one of an ordinary skilled in the art at the time of the applicant's invention to have modified Gindlesperger to incorporate the feature of updating the information related to vendors, their bids, etc which is related to charge information for the print jobs because it would enable the system to calculate the price bid for print jobs requested by the user based

on latest vendor prices rather than obsolete and old stored prices and avoid the waste

of time and money which will result by considering obsolete vendor data/prices.

Regarding claim 11, Gindlesperger teaches that said creating means makes a

user set information for the output data during executing the predetermined process (

see at least col.5, lines 28-30. The buyer's print job is a predetermined job because the

same has been already been processed by the printers/vendors to submit a bid)

Regarding claims 12-22, there limitations are closely parallel to the limitations of

claims 1-11 and are therefore analyzed and rejected on the same basis.

Conclusion

4.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

(i) US Patent 6,076,080 to Morscheck et al. discloses a computerized order entry

system for customized output data, such as printing of forms, calculating charges for the

output data and validating the order for output data with the records stored in the data

repository. Morschek et al. reference can be used to render the recited limitations in

claims 1-22.

(ii) US Patent 6,535,294 to Arledge, Jr. et al. discloses a system for " *for preparing*

a customized printed product over the Internet 50 according to the preferred embodiment hereof

includes a back-end portion 200 connected to the wholesaler web server computer 140 and supporting

operation of the front-end portion 100 of the system by an end-user thereof. More particularly, the back-

end portion 200 provides a printed products preparation system 201 having an information database

220, a stored procedures library 240 and a support files library 260. The information database 220

includes files, data and information relating to the objects of the system and method herein described,

such as product information, end-user information, order information, and the like. The stored

procedures library 240 includes files, programs, applications, applets, scripts, subroutines and the like,

which are frequently used at many different locations within the preparation system 201, such as price

calculator, customize a selected product, ... ", see at least FIG.2 and col.8, line 63-

col.9, line 67. Alredge, Jr. et al. reference can be used to render the recited limitations

in claims 1-22.

(iii) US Patent 6,717,686 B1 to Farros et al. discloses a system such that an user

can place orders for custom print jobs via Internet (see at least abstract).

(IV) US Patent 6,614,550 to Minagawa (see at least claims 1-56, col.13, line 5-

col.18, line 43) and US Patent 6,434,643 to Ejiri (see at least col.4, lines 50-61)

explicitly disclose that a control program creates the setting information.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Yogesh C Garg whose telephone number is 703-306-

0252. The examiner can normally be reached on M-F(8:30-4:00).
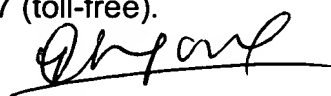
If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Vincent A Millin can be reached on 703-308-1065. The fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov.

Should you have questions on access to the Private PAIR system, contact the

Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
September 19, 2004